

**REMARKS**

The Office Action mailed November 19, 2004 has been carefully reviewed along with the references cited therein. In the Office Action, the Examiner rejected claim 9 under § 112, second paragraph, as being indefinite. The Examiner also rejected claims 14, 16-17 and 19 under § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0043830 (Imamoto) in view of an Official Notice that it is well known to attach a shaft to a club head. The Examiner also rejected claims 6-7, 10, 20, 22-24 and 26 under § 103(a) as being unpatentable over U.S. Patent No. 5,328,175 (Yamada) in view of U.S. Patent Application Publication No. US2003/0139225 (Rife). Claims 14, 18, 21 and 25 were rejected as being unpatentable over Yamada in view of Rife, as applied to claims 6-7, 10, 20, 22-24 and 26, and further in view of U.S. Patent No. 4,438,931 (Motomiya). Claim 9 was rejected under § 103(a) as being unpatentable over Yamada in view of in view of Rife, as applied to claims 6-7, 10, 20, 22-24 and 26, and further in view of Motomiya and U.S. Patent No. 5,447,311 (Viollaz et al.).

To minimize the issues in front of the Examiner, Applicant has cancelled claims 14 and 16-19. Claim 9 has been amended to depend from claim 21, to overcome the § 112 rejection.

**The Examiner erred when combining Yamada and Rife**

The Examiner combined Yamada and Rife to reject all of Applicant's pending claims. Before examining the reasons why the combination was in error, Applicant would like to provide a brief discussion of the two references.

Yamada is directed to a golf club head, made up of a main body 25 made of a first material and formed with a recess 39; and a face plate 37 made of a second material more elastic than the first material and formed with a closed air-chamber 41 embedded therein, wherein the face plate is securely received in the recess. Col. 2, lines 20-25. The main body 25 includes a back portion 33 that is curved and is not parallel to the face plate 37, as evident in FIGURE 2.

Rife is directed to a combination blade type iron and peripheral weight iron. Rife recognized that "blade refers to any non-peripheral weighted, iron type club head having an area of generally uniform thickness in a heel to toe direction" and that "blade type iron construction may be formed with a muscle back type bulge." See paragraph [0001]. In paragraph [0002] Rife also recognized that "[b]lade types of iron configurations are preferred by professional golfers." However in paragraph [0003] Rife

[illegible]

Even though the Examiner found that Yamada discloses a surface being near a top edge and substantially parallel to a front surface, a finding with which the Applicant disagrees, the Examiner went on to find that "Yamada lacks an upper surface as shown in figures 2 and 6 being the same across the length of a head forming a blade." Applicant is unsure why the Examiner chose this language since it is not found in Applicant's claims; however, for the sake of reducing the issues in this response, Applicant concedes that Rife discloses a upper blade surface of the club head where the blade surface is at least substantially parallel to the front surface. For the sake of this response, Applicant will assume that where the Examiner indicates that "Rife discloses an upper surface being the same across the length of a head forming a blade," the Examiner is referring to an upper blade surface where the blade surface is at least substantially parallel to the front surface.

When combining Yamada and Rife, the Examiner admits that "Yamada lacks an upper surface as shown in figures 2 and 6 being the same across the length of a head forming a blade." See page 4 of the final Office action. The Examiner combined FIG. 9 from Rife with Yamada under the reasoning that it would have been obvious to combine the two "to simplify the manufacturing process of a head by making the upper section the same across the length of a head." Such a motivation is not reason to combine the teachings of Rife with Yamada. It would be no simpler to manufacture the head of Yamada to have a blade surface, as opposed to the rear surface disclosed in FIGURES 2 and 6 in Yamada. Club heads are typically cast and the shape of the mold for the head can take a number of different configurations, typically none being any more difficult to cast than others. Rife provides no motivation to combine its disclosed top section with Yamada. Rather, the Examiner has created the "simpler to manufacture" rationale improperly to support the combination of references.

In fact, Rife specifically teaches away from a blade surface and a muscle back portion defining a cavity not visible from the exterior of the club head, since each embodiment in Rife discloses an exposed cavity. Similarly, Yamada provides no motivation for modifying its top section so that it would look like Rife's. Yamada only teaches using two different materials to manufacture a club head. The Examiner is reminded that the mere fact that references can be combined does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In response to the first office Action, Applicant argued that any attempt to combine Rife with Yamada would be in error. In response to Applicant's arguments, in the subject Office action the Examiner argued that "it would be obvious to modify Yamada with a top section as shown in figures 2 and 6 to be the same cross section along the length of a head as Rife disclose [sic]." The Examiner went on to state that "Yamada clearly will have a cross section along the length of a head and clearly the one shown in figures 2 and 6 (Applicant believes that the Examiner meant to state FIGURE 9 in Rife) would be an obvious selection." The Examiner provides no motivation for combining the two references other than the fact that each reference discloses a cross section. If the Examiner's reasoning for combining the references was followed, any iron golf club head, which inherently has a cross section, could be combined with any other iron golf club head, which would also inherently have a cross section. This motivation for the combination does not satisfy the requirements to support a proper rejection.

In view of the above, Applicant respectfully submits that the Examiner has failed to establish a prima facie case for obviousness against the pending claims. Accordingly, Applicant requests that the Examiner remove the rejections.

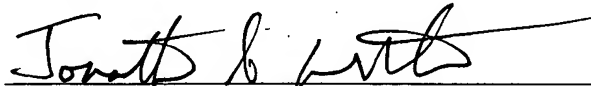
### Conclusion

In view of the above, it is submitted that the pending claims patentably define over the cited references. Accordingly, the application is in condition for allowance. An early notice to that affect is earnestly solicited.

This response is being filed with a Notice of Appeal. Should the Examiner wish to discuss the application, he is encouraged to telephone the undersigned.

Respectfully submitted,

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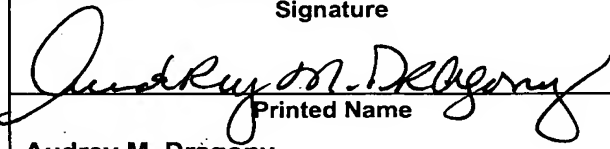
January 19, 2005  
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